

As set forth in detail below, Examiner's hindsight reconstruction of Applicant's claimed invention is improper. Moreover, the asserted combination of *Moore* and *Abe* does not disclose all Applicant's claimed features as there is no disclosure of tracking added components based on "automatically reading a second information tag." Accordingly, Applicants respectfully request withdrawal of the rejection of claims 8-13.

**A. No Evidence Of A Suggestion To Combine References**

When rejecting a claim for reasons of obviousness, the Examiner bears the initial burden of establishing a *prima facie* case of unpatentability. Specifically, to establish a *prima facie* case of obviousness, there must be some evidence of a suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art to modify the reference. MPEP 706.02(j). *See also In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (explaining that the teachings or suggestion to make the claimed invention must be found in the prior art and not based upon the Applicant's disclosure.) Where the references cited by the examiner fail to show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references," the Examiner has not carried the burden of establishing a *prima facie* case of unpatentability. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598-99 (Fed. Cir. 1988). Moreover,

a rejection cannot be predicated on the mere identification in [the references] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

*In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (holding that the Board did not make out a proper prima facie case of obviousness when it combined and modified multiple references to make the claimed invention).

Here, in order to substantiate the obviousness rejection, the Examiner must point to some particular teaching or suggestion in *Moore* or *Abe* that supports combining and modifying the two references to include the claimed steps of “automatically reading a second information tag associated with said component, and transmitting information from said second tag to said computer.” That is, the prior art *itself* must suggest the desirability of the modification. There is no such evidence of a suggestion to combine the cited references here because, in *Abe*, the barcode is read to provide instructions *at the painting station* for controlling the painting process. *Abe*, col. 3, ll. 34-37. In *Abe*, the barcode “remains legible even after several painting steps are performed.” *Id.* at ll. 20-21. The purpose of the barcode legibility is to provide instructions for the painting process which is independent of the control of the manufacturing line. There simply is no suggestion in *Abe*, to read information from different components as they pass through the assembly line process and feed that information back to the computer monitoring the line for operational control. Also, there certainly is no such suggestion in *Moore* because, as Examiner recognizes, the claimed step of “automatically reading... and transmitting...” is absent. Accordingly, there has been no showing of evidence suggesting the combination of references as Examiner has asserted.

**B. The Combination of *Moore* and *Abe* Do Not Disclose The Claimed Elements**

Notwithstanding the above, the combination of *Moore* and *Abe* do not disclose the claimed invention. This is because *Abe* does not disclose relaying component barcode information back to the computer which controls the manufacturing line. On the contrary, *Abe* discloses reading a barcode *label* which is “representative of the information and instructions


*used* in the *assembly* of each product... for *controlling* the *painting* process.” *Abe*, col. 3, ll. 33-37. That it is the barcode identification merely helps provide instructions for processing individual components wherever the processing is to take place -- independent of the location on the manufacturing line.

In contrast, the claimed invention requires “transmitting information from said second tag to said computer” wherein the computer performs “automatically determining the location” of the underlying part on which the component incorporating the second tag has been placed. As a result, the claimed invention automatically tracks not only the underlying part, but also the progress of the added parts as they are incorporated into the manufactured item. These tracking elements of Applicant’s claim are nowhere found in *Moore* and *Abe*. Indeed, Examiner admits that *Moore* does not disclose them. Further, as *Abe* merely discloses reading barcodes for information that identifies manufacturing instructions for specific processing steps where they are to be performed, there is no disclosure of tracking the manufacturing process as Applicant claims. Therefore, even if it were proper to combine *Moore* and *Abe* (which Applicants contest), there is no disclosure in the cited combination of prior art of all Applicant’s elements recited in claims 8-13.

### **CONCLUSION**

Therefore, for the reasons set forth above, Applicant’s claims 8-13 are not made obvious by the combination of *Moore* and *Abe*. Accordingly, Applicant respectfully requests withdrawal of the rejection and reconsideration and re-examination of the application.

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